

REMARKS

This paper is responsive to the Office Action mailed November 16, 2005, relating to the above-identified application. Claims **1-13** have been amended. No new matter has been added by way of these amendments.

I. Summary of Examiner's Rejections

(a) Claims 1-13 stand provisionally rejected on the ground of obviousness-type double patenting over co-pending Application No. 10/988,119 as a generic invention anticipated by the species.

(b) Claims 1-13 stand rejected under 35 U.S.C. § 112 ¶ 2, as being indefinite.

(c) Claims 1-3, 5, and 6 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 2,749,019 ("Ohlund") in view of U.S. Patent No. 2,661,142 ("Hendrickson, Jr."), U.S. Patent No. 4,511,042 ("Wischusen, III").

(d) Claim 4 is additionally rejected under the prior art raised against Claim 1 (point (c)) and further in view of U.S. Patent No. 6,227,441 ("Sagel et al.").

(e) Claims 7 and 10 stand rejected as obvious over *Ohlund* in light of either U.S. Patent No. 3,587,836 ("Brown") or U.S. Patent No. 2,983,429 ("Bergstein").

(f) Claim 8 stands additionally rejected under the prior art raised against Claims 7 and 10 (point (e)) and further in view of either U.S. Patent No. 2,685,402 ("Caster") or U.S. Patent No. 3,790,066 ("Malinowski").

(f) Claim 11 stands rejected under 35 U.S.C. § 103(a) as obvious over *Ohlund* in view of either *Brown* or *Bergstein* and either U.S. Patent No. 3,317,326 ("Peters"), or 5,180,075 ("Montalbano").

(g) Claims 12 and 13 stand additionally rejected under the prior art raised against Claim 11 (point (f)) and further in view of Sagel et al.

II. Allowable Subject Matter

(a) Claim 9 is allowable if rewritten to overcome the rejections of Section I.(b) above.

(b) The Examiner has not specifically addressed the limitations of Claim 5, nor rejected same.

III. Double Patenting (Section I.a)

Applicant does not wish to file at this time a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) since the rejection is still provisional. Applicant reserves its right to file a terminal disclaimer if the provisional rejection of claims 1-13 based on of co-pending Application co-pending Application No. 10/988,119 as a generic invention anticipated by the species matures into a formal obviousness-type double patenting rejection.

IV. Rejection under 35 U.S.C. §112 ¶2 (Section I.b)

Applicant has amended claims 1, 7, and 9-13 to respond to each of the thirteen indefiniteness rejections under 35 U.S.C. § 112 ¶ 2 raised by the Examiner. The Examiner raised seven double inclusion rejections, and six clarification requirement rejections.

Applicant has removed the plural “top-forming panels” and has replaced it with the singular form. Applicant added a singular definite article to “top-forming panel” in claim 1, line 15 and added a singular definite article to the “side-forming panels” for cohesion at line 16. Applicant has also removed the same double inclusion, has qualified the element “top panel” at line 11, and has added definite articles before each element to further qualify the definite antecedent basis of “top panel” and “side panels.”

Applicant believes both end panels found in claims 9-10 and 13 were already given sufficient antecedent basis and were not double inclusions based on the qualification in claim 7. Nevertheless, Applicant has restated the definite singular qualifier “from the pair of opposing end panels” to further distinguish “one end panel” from “the other end panel.”

Applicant added the qualifier “to the corner lock” to line 13 of claim 11 to remove any double inclusion from the element “end panel.”

Applicant has further defined the longitudinal folding crease of claim 1, lines 14–15 by adding the language “between the top-forming panel and the adjacent side-forming panel.” In claims 7 and 11, Applicant has removed the valid adjective “remote,” indicating which side panel was applicable, and now uses the term “not hinged to the base panel” to designate the same side panel. Applicant has added the term “pad” to further qualify “end panels” and added “second” and “third” to further qualify the “base panel” of claim 11, lines 20, 21, 23, and 24. Finally, Applicant has changed claim 11 to further define the traverse cut line and the end panel in relationship to the corner lock.

V. Rejection under 35 U.S.C. §103(a)

(a) Legal Requirements: Section 103.

To establish *prima facie* obviousness, (1) the modification or combination must teach all the claim limitations; (2) there must have been a suggestion or motivation in the cited references to modify or combine cited in the references at the time of the invention; and (3) there must have been a reasonable expectation of success when the combination or modification to the art was made.

Broad conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not sufficient. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *see, e.g. Elmurry v. Arkansas, Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 207, 217 (CCPA 1977). Conclusory statements must set forth the rationale on which they rely. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Before prior art references can be combined or modified, there must be some suggestion or motivation found in the art to make the combination or modification. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); *Heidelberger Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1072 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987); *Lindemann Maschinenfabrik v. Am Hoist and Derrick*, 730 F.2d 1452, 1462 (Fed. Cir. 1984).

The fact that references *can* be modified or combined is insufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *In re*

Mills, 916 F.2d 680, 682 (Fed. Cir. 1990). The showing of such suggestion, teaching, or motivation must be clear and particular. *Dembiczak* at 1617; *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). Moreover, the fact that the modification or combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999); *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1302JBd. Pat. App & Inter. 1993). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

(b) Examiner's Conclusory Statements

The Applicant notes that the Examiner has more than 20 years of experience in the art of box design and merely offered conclusory statements in lieu of directing the Applicant to needed motivations to combine in the references to maintain a 103 rejection. In fact, Mr. Gary E. Elkins was the Assistant Examiner during the prosecution of *Wischusen III* in 1984, the Primary Examiner during the prosecution of *Montalbano* in 1991, and more recently the Primary Examiner during the prosecution of *Sagel et al.* These patents were raised by the Examiner against this application. Applicant humbly believes that the expertise of the Examiner in this case is not sufficient to form *prima facie* to meet the Examiner's burden as required by case law.

There is also no basis in the Manual of Patent and Examining Procedure to support the Examiner's conclusory statements.

Hindsight is a trap to the Examiner. *In re Kotzab*, 208 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). "[I]t is not the particular examiner's expertise that gives the decisions presumptive correctness but the authority duly vested in him by his appointment as a patent examiner." *Western Electric Co. v. Piezo Technology, Inc.*, 860F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988). "Whether the changes from the prior art are 'minor' ... the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's method and device." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).

The Examiner rejected each claim of the application based on *Ohlund* in view of four to seven references for each of the rejected claims. No motivation to combine was given; instead, the Examiner merely made conclusory statements of obviousness. See November 16, 2005, Office Action, ¶¶ 5-10.

(c) General Statement in Response to the Examiner's 103 Rejection

Ohlund is the primary art raised in this case against all claims rejected on the ground of obviousness (claims 1-8, 10-13). *Ohlund* issued in 1956 and is directed to a bread box designed to replace bulky wooden boxes used for temporary storage during the delivery of fresh bread. The *Ohlund* box has no handle and does not contemplate or teach the use of any grasping system in

association with the box. In fact, *Ohlund* teaches that the box is light and can easily be slid into position (col. 1, ll. 69–71) in the back of a bakery delivery truck (col. 1, ll. 21–23). Mechanical strength was not at issue in this invention and the lip-type feature (element 12) is accordingly called a glue tap. Aside from corner closing mechanisms, *Ohlund* is unrelated to Applicant's invention.

(d) Applicant Challenges the Notice under MPEP 2143.03(c)

Applicant challenges the factual assertions made by the Examiner based on the common knowledge that (a) handle-forming panels in carton blanks are notoriously well known in this art (page 5, paragraph 5); and (b) lock flaps with handle panels are well known in this art (page 6, paragraph 8).

Applicant traverses these findings, stating that these are conclusory blanket statements and irrelevant to the Applicant's specific invention. Applications for novel models of cars with specific and uniquely adapted doors should not be rejected under 103 as obvious simply because the use of doors is generally well known in the art of car making. The use of cardboard as a material for box blanks may be judicially noticed, not the art of handle making.

Applicant invites the Examiner to provide documentary evidence required in order to maintain the rejection for a subsequent Office Action. *See* 37 C.F.R. 1.104(c)(2).

(e) Rejection of Claims 1–3, 5, and 6

The Examiner claims that, based on *Ohlund*, it is obvious to one skilled in this art to (1) hingedly connect a lip forming panel to a base, (2) add handles that merge in the top and side panels, (3) create handles that collapse when

not in use, and (4) reinforce the container by using the lip. In support, the Examiner sites *Hendrickson, Jr.*, and *Wischusen III*.

The art of box-making, much like origami, the Japanese art of folding paper, is vulnerable to hindsight and over simplification of the arrangement of what may seem like simple elements to form novel and complex structures. The Examiner admits the primary prior art does not have the following five elements: (1) the lip-forming panel, (2) an opposing side-forming panel with approximately equivalent lateral extent, (3) a pair of handle-forming portions, (4) opposed handle-forming portions, and (5) handles offset from the longitudinal creases. Glancing at Applicant's claims next to *Ohlund* highlights the plurality of fundamental differences between the two.

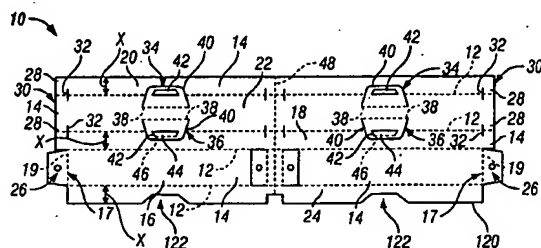
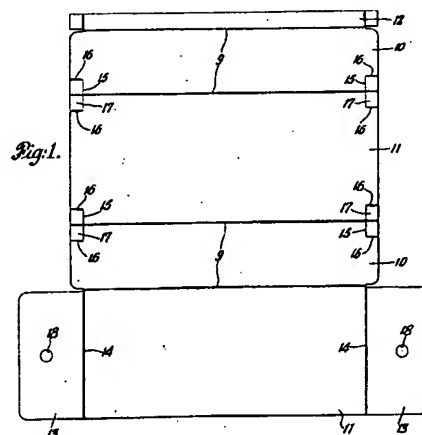


FIG. 1

Applicant



Ohlund

Applicant believes such a plural-element transformation exceeds the statutory grant of 35 U.S.C. § 103. The Examiner believes that *Wischusen III* may teach Applicant's lip-forming panel. However, in fact, *Wischusen III* teaches away from Applicant's invention. *Wischusen III* explains that only the side panels hold the top and bottom panels, not the glue panel (col. 3, ll. 1-4).

The Examiner finally proposes *Hendrickson, Jr.* as a reference that discloses possibly similar handles since *Hess*, *Baker* and *Wischusen III* all disclose stacking boxes without such handles. The fact that the first three references are types of boxes without handles clearly teaches away from the *Wischusen III* handles.

A large portion of the elements in Applicant's claims are not disclosed or suggested in *Ohlund*. The record does not show any motivation to combine the cited references. Applicant humbly disagrees with the Examiner and believes its claims are allowable.

Regarding claim 5, the Examiner failed to specifically identify the structural elements required therein. Accordingly, Applicant must conclude that claim 5 is therefore, allowable.

(f) Claims 4, 12-13

Claims 4, 12-13 are additionally rejected under the prior art raised against claim 1 (Section I.e) in view of U.S. Patent No. 6,227,441 ("*Sagel et al.*"). Applicant incorporates the arguments of Section V.e, above, and states further that *Sagel et al.* describes a breakable center line (CL) where weakness is created by a series of perforations (col. 4, ll. 15-17). Holes are used during perforation, not cut lines as described in Applicant's specification (par. 0029, ll. 1-7). Again, the element is not found in the suggested reference.

(g) Claims 7 and 10

Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) as obvious over *Ohlund* in view of either U.S. Patent No. 3,587,836 ("Brown") or U.S. Patent No. 2,983,429 ("Bergstein").

Applicant reincorporates the arguments of Section V.e and further provides that none of the references define two distinct positions for handling the box, all describe an invention where handles can be used with a single operating position.

(h) Claim 8

Claim 8 is additionally rejected under the prior art raised against claims 7 and 10 in view of U.S. Patent No. 2,685,402 ("Caster") or U.S. Patent No. 3,790,066 ("Malinowski").

Applicant reincorporates the arguments of Section V.g and further states that, once again, the Examiner has selected patents that disclose by themselves a new element missing from Applicant's invention. In essence, the Examiner now rejects claim 8 based on six missing elements selected from a plurality of existing sources without any motivation or suggestion to combine or documentary evidence of any notice or knowledge recognized of the Examiner.

(i) Claim 11

Claim 11 is rejected under 35 U.S.C. § 103(a) as obvious over *Ohlund* in view of either *Brown* or *Bergstein* and either U.S. Patent No. 3,317,326 ("Peters") or 5,180,075 ("Montalbano"). This time, the Examiner reconstructs

the required elements of a claim from seven different patents and wants the Applicant to believe it was obvious to combine all of these references even if no motivation is given.

Applicant incorporates the arguments previously made regarding the first five patents and is at best perplexed by the choice of 103 references to meet a seventh missing element in this claim: a pad. *Peters* discloses a multilayer tray system for a storage box (Fig. 1), and *Montalbano* describes a pizza delivery system with pizza trays, not a pad. Both of these system describe a multilayer tray system, which are not even closely related to Applicant's claimed structure.

(j) Claim 5

The Examiner has not provided any evidence in support of a rejection of any claim that end-forming panels moving rotationally in the same direction was known in the art.

VI. Conclusion

Based on the above amendments and remarks, Applicant submits that claims 1-13 are now in proper condition for allowance, and such action is earnestly solicited. The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 22-0259 or any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is also invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

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